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Carolyn P. Stanton Date: February 28, 2006

Name: Carolyn P. Stanton

Attorney Docket No.: 78200-040

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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| APPLICANT | : | Jean-François Courtoy, et al. |
| SERIAL NO. | : | 10/046,019 |
| CUSTOMER NO. | : | 23526 |
| FILED | : | January 11, 2002 |
| FOR | : | SELECTIVELY EMBOSSED SURFACE COVERINGS AND PROCESS OF MANUFACTURE |
| ART UNIT | : | 1771 |
| EXAMINER | : | Hai Vo |

MAIL STOP AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

**PRE-APPEAL REQUEST FOR REVIEW**

SIR:

Please consider the following remarks in respect of the legal and factual deficiencies in the Final Rejection mailed December 2, 2005. The rejected claims are 33, 47, 50-52, 54 and 56-58 as fully set forth in applicants' most recent Amendment.

**The Rejected Claims are not**
**Product by Process Claims**

The claims have been rejected as product by process claims and they are not product by process claims. The claims are in a form commonly used for product claims in the resilient surface covering art. For example, claim 33 reads, in part, "the cured layer disposed over the first ink is mechanically embossed with a UV cured first mechanically embossed texture". The terms in this passage, such as, "is mechanically embossed" and "a UV cured first mechanically embossed texture" describe product characteristics that can be determined by observation or physical or chemical analysis. These are not process steps. The same is true of other claim language such as the term "chemically embossed" in claim 50. The term "chemically embossed" can be used to describe a process as can the other terms referenced above. But in the rejected claims, the terms are not used to describe a process. They are used to describe physical and chemical elements of the claimed product that can be determined by one skilled in the art.

All of the claims have been improperly rejected as product by process claims and the rejections should be withdrawn.

**The Rejection under 35 U.S.C. §103 Fails to**
**Consider the Essential Elements of the Invention**

The claimed invention has to do with synthetic surface covering products having selectively embossed surface areas which provide a more realistic appearance. The products contain a mechanically embossed surface texture in register with a design

printed with an ink containing a photoinitiator. The selectively mechanically embossed surface texture is in a cured coating or cured layer overlaying the ink. UV cross-linking (curing) is present in the areas that are mechanically embossed and the cured coating or cured layer contains a cross-linked photopolymer or monomer. No combination of the cited art teaches or suggests a surface covering having the elements of a selectively mechanically embossed UV cured texture in the form of a design overlaying an ink printed in the design and containing a photoinitiator.

The 35 U.S.C. §103(a) rejection is made over Brossman, et al. (U.S. Patent No. 6,613,256) in view of Rutsch, et al. (U.S. Patent No. 5,147,901). Brossman discloses a chemically and mechanically embossed surface covering having selective mechanical embossing over the chemically embossed areas of the surface. The mechanically embossed areas are thermally cured and they are limited to the same areas where the product has chemical embossing.

It is admitted in the Final Rejection that Brossman does not teach that the top coat is mechanically embossed with a UV cured mechanically embossed texture. But all of applicants' claims require a UV cured mechanically embossed texture. The rejection attempts to cure the deficiencies of Brossman by combining it with Rutsch.

Rutsch discloses photoinitiators which can be combined with other compositions for photopolymerization of thin layers and printing inks. Another field of use is described by Rutsch as UV curing of plastic coatings, for example, floor coverings. The Rutsch propiophenones also are said to possess an increased resistance to yellowing. However, there is no discussion in Rutsch that the increased resistance to yellowing is effective in his printing inks and there is no discussion in Rutsch that printing inks

containing his photoinitiators are used in floor covering. The photoinitiator in the Rutsch inks is for curing the ink and there is no suggestion to make a photoinitiator containing ink in Rutsch which would have sufficient photoinitiator to cure a coating overlying the ink.

No combination of Rutsch with Brossman teaches or suggests that any portion of a topcoat layer can be UV cured using a photoinitiator from a photoinitiator containing ink that is printed below the topcoat layer. There is no teaching or suggestion in either of the references of a surface covering product having a UV cured mechanically embossed design which follows the printed design of an ink containing a photoinitiator. The rejection of all of the claims over Brossman in view of Rutsch is accordingly without merit and should be withdrawn.

**Double Patenting**

Applicants will address this issue as appropriate when allowable subject matter is found in the co-pending application.

A Notice of Allowance is respectfully requested.

Respectfully submitted,

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Date: February 28, 2006